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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,181	05/29/2001	Dana Howard Jones	513612000100	6792

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EXAMINER	
POND, ROBERT M	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/867,181	JONES, DANA HOWARD	
	Examiner	Art Unit	
	Robert M. Pond	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant requested reconsideration of the pending claims. All pending claims (1-39) were examined in this final office Action.

Response to Arguments

Applicant's arguments filed 13 December 2005 have been fully considered but they are not persuasive.

- Premium content is just content.
- Goldhaber discloses consumers already paying attention without any individual profile information (please see at least col. 2, lines 36-45).
- Profile information makes Goldhaber very effective, but Goldhaber is very clear that each consumer can delete any profile information or transaction history- an empty profile record (see at least col. 6, lines 46-61).
- Goldhaber requires previewing a message before accessing the content or making a purchase through buying and selling stock (see at least col. 7, lines 28-46; col. 8, lines 1-39; col. 11, lines 25-32).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-3, 6, 7, 10-32, 34, 37, and 38 are rejected under 35 USC 102(b) as being anticipated by Goldhaber et al. (Paper #2, US 5,794,210, hereinafter referred to as "Goldhaber").**

Goldhaber teaches all the limitations of Claims 1-3, 6, 7, 10-32, 34, 37, and 38. For example, Goldhaber discloses a method of advertisers gaining the attention of consumers accessing the Internet via attention brokerage and compensating consumers who pay attention to the advertisement (please see at least title, abstract; col. 4, lines 34-35; col. 9, lines 34-36). Goldhaber discloses advertisers as sponsors embedding advertisements with content most likely to reach the advertiser's target audience referred to as linking sponsorship (see at least col. 2, lines 24-27). Goldhaber discloses decoupling advertising from the content referred to as orthogonal sponsorship (see at least col. 5, lines 46-47). Goldhaber further discloses:

- *Providing a product at a networking site; product covered by intellectual property:* (see at least abstract; Fig. 1 (102); col. 1, lines 4-8; col. 3, lines 51-55; col. 5, lines 11-13; col. 6, lines 3-7; col. 9, lines 32-41).

- *Restricting access to product:* restricts access to valuable information until information provider receives compensation (e.g. television program, prerecorded music, magazine or newspaper article, research report)
- *Facilitating the display of a sponsor message to a consumer:* (see at least abstract; col. 9, lines 62-67).
- *Allowing access to a product after facilitating display; purchasing product:* seeing an ad and requesting the film clip; making a purchase (see at least Fig. 13 (314); col. 5, lines 11-13; col. 18, lines 53-55).
- *Maintaining a consumer activity log:* creates consumer profile; maintains profile, updates profile (see at least col. 13, line 33 through col. 14, lines 56).
- *Authoring sponsor message:* advertiser creates ad at site (see at least Fig. 8 (68, 106); col. 14, lines 17-20).
- *Consumer sign-up:* providing personal data, contact data, profile data, taking acceptance action, password (see at least col. 12, line 45 through col. 13, line 40).

Well Within the Skill (pertaining to Claims 9, 33, and 39)

The Applicant did not traverse the examiner's assertion of well within the skill based on the merits of well within the skill. The well within the skill statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 4, 5, 8, 35, and 36 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (Paper #2, US 5,794,210), in view Wiser et al. (Paper #2, US 6,385,596 hereinafter referred to as "Wiser").

Goldhaber teaches all the above as noted under the 102(b) rejection and teaches a) advertising intellectual property products, b) compensating information providers for purchased content (e.g. prerecorded music, television programs, search reports), and c) trading houses providing automatic royalty tracking (see at least col. 19, line 19 through col. 20, line 53; col. 20, lines 54-55), but does not disclose making royalty payments. Wiser teaches protecting a content owner's intellectually property rights over a network, and further teaches tracking and making royalty payments to a content owners and facilitators (see at least col. 9, lines 39-53; col. 11, lines 49-61). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber to disclose making royalty payments as taught by Wiser, in order to disclose the purpose of royalty tracking, and thereby attract content owners and facilitators to the service desiring to be paid royalties.

Goldhaber teaches all the above as noted under the 103(a) rejection, but does not disclose entering into a license agreement with the owner of the intellectual property. Wiser teaches all the above as noted under the 103(a) rejection and further teaches consumers and facilitators entering into a license agreement with the owner of intellectual property (see at least abstract; Fig. 1A (108, 116); Fig. 1B (110); col. 1, lines 45-47; col. 5, lines 56; col. 10, lines 18-48). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber to implement licensing as taught by Wiser, in order to protect the intellectual property rights of the product owner.

3. **Claims 9 and 39 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (Paper #2, US 5,794,210).**

Goldhaber teaches all the above as noted under the 102(b) rejection and further teaches inactivating a CyberCoin to prevent a consumer from receiving additional compensation by merely accessing the same advertisement (see at least col. 17, lines 49-52), but does not disclose barring the owner of intellectual property from pretending to be a consumer. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose barring the content provider from pretending to be a consumer, since it is well within the skill to ascertain that content providers are capable of abusing the system as well as consumers.

4. **Claim 33 is rejected under 35 USC 103(a) as being unpatentable over Goldhaber (Paper #2, US 5,794,210).**

Goldhaber teaches all the above as noted under the 102(b) rejection and teaches advertisers directly compensating a consumer via payment for viewing and paying attention to an advertisement, and further teaches a consumer using the payment to compensate the information provider via another payment for providing entertainment or other information the consumer wishes to access (see at least col. 12, lines 5-11). Goldhaber, however, does not teach the consumer viewing a sponsor message as an alternative to direct payment for the selected product. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose the consumer viewing a sponsor message as an alternative, since it is well within the skill to ascertain the sponsor could have paid the entertainment content provider directly for the content the consumer desired.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-6760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Pond
Primary Examiner
April 14, 2005